

OCT 14 2005

REMARKS

Claims 1-24 and 26-43 were examined. Claim 1 is amended. Claims 1-24 and 26-43 remain in the Application.

The Patent Office rejects claims 1-5, 7, 10, 14-16, 19-22, 26 and 37 under 35 U.S.C. §102(b). The Patent Office rejects claims 8-9 and 17-18 under 35 U.S.C. §103(a). Reconsideration of the pending claims is respectfully requested in view of the above amendments and the following remarks.

A. 35 U.S.C. §102(b); Rejection of Claims 1-5, 7, 10 & 14-15

The Patent Office rejects claims 1-5, 7, 10 and 14-15 under 35 U.S.C. §102(b) as anticipated by U.S. Patent No. 5,810,809 of Rydell (Rydell).

Independent claim 1 is not anticipated by Rydell, because Rydell does not describe a surgical instrument comprising a tube having a distal end and a proximal end and defining a lumen therethrough, and the distal end including a cutting edge; a shaft within the lumen of the tube and having a distal end including a blade; and a handle coupled to a proximal end of the tube and having an opening therethrough in communication with the lumen, wherein the lumen of the tube has a dimension suitable to accommodate, in addition to the shaft, an auxiliary instrument inserted through the opening in the handle. With respect to the lumen having a dimension suitable to accommodate an auxiliary instrument in addition to the shaft, this is described in the Application at, for example, page 13, lines 5-12. With respect to a handle coupled to a proximal end of a tube, this is described in the Application at, for example, page 10, lines 14-15. With respect to a handle having an opening in communication with a lumen of the tube, this is also described in the Application at, for example, page 13, lines 5-12.

Rydell describes an arthroscopy instrument for debriding tissue including inner tubular cutter member 24 including opening 23 and outer tubular member 20 including opening 22. In use, tissue is effectively macerated and sucked back through lumen 54 in the handle back to collection jaw 28, via tubing 30. See col. 5, lines 5-54. No lumen for an auxiliary instrument is described.

Claims 2-3, 7, 10, and 14-15 depends from claim 1 and therefore contain all the limitations of that claim. For at least the reasons stated with respect to claim 1, claims 2-3, 7, 10 and 14-15 are not anticipated by Rydell.

Claim 43 depends from claim 42 and therefore contain all the limitations of that claim. For at least the reasons stated with respect to claim 42, claim 43 is not anticipated by Rydell.

Applicants respectfully request that the Patent Office withdraw the rejection to claims 1-5, 7, 10 and 14-15 under 35 U.S.C. §102(b).

D. 35 U.S.C. §102(b): Rejection of Claims 16 & 19-22

The Patent Office rejects claims 16 and 19-22 under 35 U.S.C. §102(b) as anticipated by U.S. Patent No. 5,112,299 of Pascaloff (Pascaloff).

Claim 16 is not anticipated by Pascaloff because Pascaloff does not describe a surgical instrument including a tube having a distal end including an outer cutting edge extending longitudinally therefrom. Pascaloff describes sheath member 20 including a pair of longitudinally extending, diametrically opposed tabs 44 and 46 and cutting blade member 18 having serrated edges 70, 72, 74 and 76 on distal tabs 52 and 54. When cutting member 18 rotates within sheath member 20, the serrated edges of tabs 52 and 54 affect a cutting action in cooperation with the straight cutting edges on tabs 44 and 46 of sheath member 20 to sever tissue. Thus, Pascaloff does not disclose an outer cutting edge extending longitudinally from the tube and a blade extending longitudinally from the tubular shaft.

Claims 19-22 depend from claim 16 and therefore contain all the limitations of that claim. For at least the reasons stated with respect to claim 16, claims 19-22 are not anticipated by Pascaloff.

Applicants respectfully request that the Patent Office withdraw the rejection to claims 16 and 19-22 under 35 U.S.C. §102(b).

E. 35 U.S.C. §103(a): Rejection of Claims 8-9 & 17-18

The Patent Office rejects claims 8 and 9 under 35 U.S.C. §103(a) as obvious over Rydell in view of U.S. Patent No. 5,190,541 to Abele, et al. (Abele). Abele is cited for teaching a rotational cutting tool having electrodes in a bi-polar manner.

Claims 8-9 depend from claim 1 and therefore contain all the limitations of that claim. For at least the reason stated with respect to claims 8-9 are not obvious over the cited references.

The Patent Office rejects claims 8-9 and 17-18 under 35 U.S.C. §103(a) as obvious over Pascaloff and Rydell and Pascaloff, Rydell and Abele, respectively. Rydell is cited for the

teaching of electrically energizing either the blade or the outer cutting edge of the surgical instrument of Pascaloff. Claims 17-18 depend from claim 16 and therefore contain all the limitations of that claim. Claims 17-18 are not obvious over the cited references, because the references fail to disclose provide any motivation for a surgical instrument including a tube having an outer cutting edge extending longitudinally therefrom, the tubular shaft including a blade extending longitudinally from a distal end and a lumen of a tubular shaft having a dimension suitable to accommodate an auxiliary instrument. In this regard, the discussion of each of Pascaloff and Rydell with respect to previously discussed claim is relevant here as is the discussion of Rydell with respect to claim 1. Applicants respectfully request the Patent Office withdraw the rejection to claim 17 under 35 U.S.C. §103(a).

CONCLUSION

In view of the foregoing, it is believed that all claims now pending patentably define the subject invention over the prior art of record and are in condition for allowance and such action is earnestly solicited at the earliest possible date.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

Date: 10/14/05

William T. Babbitt
William Thomas Babbitt, Reg. No. 39,591

12400 Wilshire Boulevard
Seventh Floor
Los Angeles, California 90025
Telephone (310) 207-3800
Facsimile (310) 820-5988

I hereby certify that this correspondence is being transmitted by facsimile on the date shown below to the United States Patent and Trademark Office.

Nedy Calderon
Nedy Calderon

10/14/05
Date